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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,555	09/01/2000	William O. Mattick	P_3009.002 Ames	5462

23399 7590 11/16/2004

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EXAMINER

SMITH, JEFFREY A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/653,555

Applicant(s)

MATTICK ET AL.

Examiner

Jeffrey A. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/6/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

The reply filed August 12, 2004 has been entered. Claims 1-14 have been cancelled. Claims 15-57 have been added. An action on the merits of claims 15-57 follows.

Specification

The disclosure is objected to because of the following informalities:

The specification should be amended to contain a section such as that which follows:

-- CROSS-REFERENCE TO SUBMITTED APPENDICES

The following material has been filed as Appendices to the present application:

Appendix A: "Car/Truck Brand/Model Awards, 2001 Model Year Criteria Description"; and

Appendix B: "Evaluating the Environmental Performance of Passenger Vehicles".--

Appropriate correction is required.

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The claims are directed to essential subject matter which is incorporated by reference to Appendices A and B. Such essential subject matter should be bodily incorporated into the text of the specification to ensure that the subject matter essential to satisfying the written description requirement of 35 USC 112, first paragraph forms part of the printed patent upon issue. Such requirement is consistent with the Office's incorporation by reference policy and is being made in order to ensure that reasonably complete disclosures are published as U.S. Patents in order to provide the public with a patent disclosure which minimizes the public's burden to search for and obtain copies of documents which may not be readily available.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

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the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification is not enabling for a method comprising the step of estimating forecasts of sales (claims 15 and 45). Although the act of estimating forecasts of sales is disclosed (at page 21, lines 15-18; and at Appendix A, page 1, Note 1), the specification does not enable one of ordinary skill in the art to actually generate the estimates in a manner acceptable for further manipulation in the method. It is noted that the disclosure identifies obtained forecasts as being "trade secrets" (page 21, lines 7-14). Such identification as "trade secrets" of these obtained forecasts suggests that the level of complexity involved in estimating a forecast of sales prevents one of ordinary skill in the art from readily ascertaining or discovering the algorithm involved simply from a presentation of the algorithm's result. Accordingly, and as equally applied to the step of estimating forecasts of sales, the skilled artisan is unable to glean any particular algorithm for use in estimating forecasts of sales based upon the mere indication that such estimating is performed and a forecast is developed.

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The following is a quotation of the second paragraph of 35

U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 15 and 45: The scope of the recitation of an "presenting an award" is not clear. It is not clear if an actual physical award is presented or if merely a recognition as a top performer is acknowledged. The specification discloses that the presentation of an award is the actual physical presentment of a physical award such as a trophy or a plaque (specification at page 7, lines 23-28; page 9, 13-16; page 16, line 30-page 17, line 9), however further recitations in claims 15 and 45 provide evidence that Applicant intends for the term "award" to be different than that of a "physical award". This is because claims 15 and 45 recite "communicating said results and said awards to said consumers". The specification discloses that "it is necessary to design and execute a Web site that communicates the environmental performance awards to the public"

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(page 23, lines 27-30). When taken together with the recitation of what is construed (based upon the specification) to be "physical awards", it is unclear in what manner the physical awards (which are presented to manufacturers) are also communicated (presumably physically) to consumers. It is believed that this issue may be largely a semantic one and that Applicant intends for the claims to recite that the identities of award winners are communicated to consumers--rather than the awards themselves.

Regarding claims 46-57: Applicant should review the dependencies of this group of claims. It appears that dependent claims in this group were intended to depend either directly or indirectly from claim 45--rather than claim 15. Applicant must make the appropriate corrections.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-57 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

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The preambles of each of claims 15 and 45 recite "a method of sustaining the environment using the Internet....". Such recitation of "sustaining the environment", per se, is viewed as being an incredible allegation because the body of the methods set forth steps converting vehicle environmental performance data into information that is useful both to consumers in their goods/services purchasing decisions, and to manufactures in enhancing marketing of their goods/services for sale to consumers. Although, the ultimate purchasing decisions and/or the marketing of goods/services may contribute to either positive or negative environmental impact in some sense, the practice of the method steps themselves do not serve, in-and-of-themselves to "sustain the environment". Applicant may overcome this rejection by the submission of persuasive evidence that demonstrates that the method steps, as recited, thus performed result directly in sustaining the environment as recited. See MPEP 2107.01 (II).

Claims 15-57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the

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progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates

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abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a

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target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street*

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never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

An analysis of the instant claims follows:

First prong: The claims do not provide a useful, concrete, and tangible result.

Given Applicant's incredible allegation that the method provides the result of "sustaining the environment by using the Internet", it must also follow that the claims fail to provide a useful, concrete, and tangible result. The claims cannot be viewed as providing a useful result since the allegation, as held, cannot be attributed to the execution of the method steps themselves. Additionally, the claims cannot be viewed as providing a concrete result since the method steps themselves fail to provide a definitive result that the skilled artisan

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would recognize as serving to "sustain the environment".

Finally, the claims cannot be viewed as providing a tangible result since execution of the method steps themselves fail to provide any material characteristic difference between the "environment" before the execution of the method steps themselves and after the execution of the method steps themselves.

Second prong: The claims do not involve a specific application of technology in any non-trivial manner.

Although the claims recite technology, such technology is not applied in the method steps in a specific and non-trivial manner.

Claims 15 and 45 recite "using the Internet" in the preambles of the respective claims. Such invocation of "technology" is not considered to be a specific and non-trivial application of technology. The mere recitation of "technology" in the preamble does not indicate an application of the Internet to any of the specific method steps recited in the bodies of the respective claims. Moreover, the mere recitation of "using" does necessarily invoke only a non-trivial application of the Internet in the bodies of the claims. Since the Internet is a

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collection of inter-networked computers it is easily envisioned that "use" of the Internet may constitute anything from the trivial transfer of data to the non-trivial transformation of data.

Claims 15 and 45 further recite "presenting awards to manufacturers". It is noted that an "award" is disclosed as a "physical award" (e.g. trophy or plaque: see page 16, lines 30-32). Arguably, such physical award can be construed as "technology". However, the mere presentation of "technology"--in this case, an "award"--is viewed as being a trivial involvement of "technology". This is because the "technology" itself (i.e. the "award") neither affects nor effects the method in a manipulative sense. That is, the "award" itself neither acts on or is acted on in any material manner. The "award" is merely "presented". There is no transformation of the "award" nor does the "award" serve to act on any other "technology" or effect any other manipulative step in any non-trivial manner. Similar recitations in claims 21, and 51 are noted and are held to amount to trivial involvement of technology for the reasons stated above.

Claims 15 and 45 additionally recite "establishing an Internet web site". The mere establishment of an Internet web site is tantamount to a step of merely providing an Internet web

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site. Although an Internet web site invokes some semblance of "technology", the mere establishment or provision of a "technology" does not move to invoke an implementation of such technology in the method in any specific and non-trivial manner. This is because there is no recitation that the web site itself serves to specifically act on any other "technology" or specifically effect any other manipulative step in any non-trivial manner.

Claims 15 and 45 finally recite "using said Internet web site to communicate said awards to said consumers for their vehicle purchasing decisions". The recitation that the "technology" (i.e. the web site) is "[used]" does not move to impart any specific application of the web site in communicating information to the consumers. Moreover, this recitation otherwise amounts to the mere communication of some form of information to consumers. Such communication is considered a trivial application of "technology". This is because the information communicated is merely transferred from said web site to said consumers. The step of communicating such information does not otherwise involve a non-trivial application of the web site in the handling or management of the information forming the subject of the communication. Similar recitations

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in claims 44, and 57, are noted and are held to amount to trivial involvement of technology for the reasons stated above.

Absent any specific and non-trivial application of technology, the methods recited merely set forth an abstract idea which is held to be ineligible subject matter under 35 USC 101. Other steps recited in the claims involve no specific application of technology which would serve to convert the otherwise ineligible subject matter to eligible subject matter. Such other steps include data collection, data sorting, and data manipulation. Such steps remain as mental contrivances which are not recited as being specifically performed by any form of "technology".

Allowable Subject Matter

Claims 15-57 are allowable over the prior art of record.

Response to Arguments

Applicant's arguments with respect to claims 15-57 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

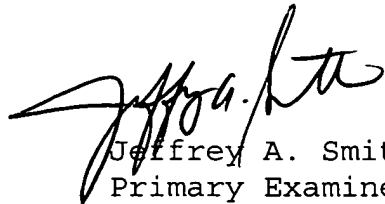
Beldock (U.S. Patent No. 6,490,565 B1) discloses an environmental certification system and method. Use of the certification mark by a complying participant has value in the marketplace and signifies the participant's dedication and actions with respect to environmental concerns.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is 703-308-3588. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey A. Smith
Primary Examiner
Art Unit 3625

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